

### REMARKS/ARGUMENTS

This Amendment accompanies a Request for Continued Examination (RCE) and responds to issues presented in the Official Action of May 5, 2009, a Final Rejection.

The above amendments to claim 1 are responsive to comments contained in the Final Rejection and serve to not only clarify the claims but distinguish them from the applied prior art.

The Official Action includes two separate rejections, the first directed to previous claims 1-4, 6, and 19-21 based upon a single reference and a separate, subsequent rejection, based upon a combination of two references.

The amendments to claim 1 are mainly based on the descriptions in the specification as originally filed: in lines 4 to 23 on page 12 (as to the radical polymerization initiator); in lines 8 to 23 on page 17; in lines 1 to 8 on page 21; and from line 6 on page 36 through line 10 on page 38 (Example 6).

The significance of the amendments made to claim 1 are as follows:

To establish a case of *prima facie* obviousness, all of the claim limitations must be taught or suggested by the prior art. *See* M.P.E.P. § 2143.03. A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. *In re Kahn*, 78 USPQ2d 1329, 1334 (Fed. Cir. 2006) citing the legal standard provided in *Graham v. John Deere*, 148 USPQ 459 (1966). The *Graham* analysis needs to be made explicitly. *KSR v. Teleflex*, 82 USPQ2d 1385, 1396 (2007). It requires findings of fact and a rational basis for combining the prior art disclosures to produce the claimed invention. *See id.* (“Often, it will be necessary for a court to look to interrelated teachings of multiple patents . . . and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue”).

The use of hindsight reasoning is impermissible. *See id.* at 1397 (“A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning”). Thus, a *prima facie* case of obviousness under Section 103(a) requires “some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct.” *Kahn*, 78 USPQ2d at 1335; *see KSR*, 82 USPQ2d at 1396. A claim

which is directed to a combination of prior art elements “is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *Id.* at 1396. Finally, a determination of *prima facie* obviousness requires a reasonable expectation of success. See *In re Rinehart*, 189 USPQ 143, 148 (C.C.P.A. 1976).

Neither Golander et al (US 4,840,851) nor Vesley et al (US 6,960,275) discloses or suggests the claimed feature in “a method of manufacturing a water-absorbing shaped body” according to the present invention as recited in amended independent claim 1. This feature corresponds to the combination of (i) the feature, “(the aqueous solution) further includes a radical polymerization initiator other than the photo polymerization initiator” (the feature of (former) pending claim 4) and (ii) the feature, “polymerization is furthered by applying heat after the light is radiated” (the feature of (former) claim 5).

The passage in Vesley which the Examiner points out “discloses the feature corresponding to the feature of pending claim 5”, merely discloses the technical feature of “polymerization by applying heat instead of radiating light”. Please note that in the manufacturing method of Vesley et al, polymerization is not furthered by “applying heat after radiating light intermittently”.

As the Examiner correctly acknowledges (page 3, 6<sup>th</sup> paragraph, first sentence), Golander et al discloses no feature corresponding to the feature of pending claim 5 now incorporated into independent claim 1.

Therefore, even following the descriptions in Golander et al and Vesley et al, it is impossible to attain “a method of manufacturing a water-absorbing shaped body” according to the invention recited in amended independent claim 1.

Furthermore, in the present invention (the invention recited in independent claim 1), a heat source in “applying heat after the light is radiated” is intended and implicit to be the heat of polymerization instead of heat applied from an external source. Though there is no description in the specification with regard to this point, it is common general technical knowledge known to a person skilled in the art that heat, which is generated by the polymerization, increases the temperature of the aqueous solution; namely, the heat is applied to the aqueous solution.

Accordingly, a distinction from the prior art is that applicants are able to use with advantage the heat generated from the polymerization reaction which is used for "applying" or generating heat after the intermittent radiating light is employed.

As to the remaining independent claims 7, 21 and 22, the same comments and observations as presented above apply as well. The disclosures of either of the applied documents, or both of them, do not reasonably suggest the subject matter defined by these three independent claims (or claim 1 as well).

The combination of the Golander et al and Vesley et al patents do not render obvious the claimed invention because all limitations of independent claims 1, 7, 21 and 22 are not fairly taught or suggested in the cited patents. Moreover, claims depending from those independent claims are also not made obvious by the documents because the limitations of an independent claim are incorporated in their dependent claims. M.P.E.P. § 2143.03 citing *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988).


Withdrawal of the Section 103 rejections is requested because the claimed invention would not have been obvious to the ordinarily skilled artisan at the time Applicants made their invention.

Having responded to all of the pending rejections contained in the Office Action, Applicants submit that the claims are in condition for allowance and earnestly solicit an early Notice to that effect. The Examiner is invited to contact the undersigned if any further information is required.

Respectfully submitted,

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